UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,353	02/23/2004	Kenneth L. Miller	04-7131	2325

63710 7590 02/28/2011

INNOVATION DIVISION
CANTOR FITZGERALD, L.P.
110 EAST 59TH STREET (6TH FLOOR)
NEW YORK, NY 10022

EXAMINER	
GRANT, MICHAEL CHRISTOPHER	

ART UNIT	PAPER NUMBER
3716	

MAIL DATE	DELIVERY MODE
02/28/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,353	MILLER, KENNETH L.	
	Examiner	Art Unit	
	MICHAEL GRANT	3716	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 22-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 22-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *see attached*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

IDS Mail Dates were: 9/3/2009, 9/9/2009, 12/29/2009, 11/5/2009

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 13, 25, 26, 29, 37, 38** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. **Claim 1** recites the limitation of "from a player choices [sic] a plurality of races...". It is unclear what is intended by this limitation.

4. **Claim 13** recites the limitation "the first selection of races." There is insufficient antecedent basis for this limitation in the claim.

5. **Claim 25** recites the limitation "a processor *having* an interface." It is unclear what is intended by this limitation, however, for purposes of this Office Action, this limitation is interpreted to mean that the processor is programmed with code that generates a user interface.

6. **Claim 29** recites the limitation "the selected winners." There is insufficient antecedent basis for this limitation in the claim.

7. **Claim 37** recites several limitations that are the same as or similar to limitations in claim 1, upon which claim 37 depends. Those limitations include, as stated in claim 37, "each of a plurality of players," "a plurality of races," "each player," and "a non-

consecutive plurality of races." It is unclear what is intended by these limitations, in the context as stated.

8. **Claim 38** recites several limitations that are the same as or similar to limitations in claim 1, upon which claim 38 depends. Those limitations include, as stated in claim 38, "the wager," "a winner," "a non-consecutive plurality of contests," "winning player," and "the player." It is unclear what is intended by these limitations, in the context as stated.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27 and 28 is rejected under 35 U.S.C. 101 because they cover both non-statutory subject matter and statutory subject matter. More specifically, Claims 27 and 28 are directed to computer readable media that cover signals per se, which are non-statutory subject matter.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to

cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. Cf. Animals - Patentability, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal per se is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. See, e.g., Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473 (Fed. Cir. 1998).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claim 15** is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,727,067 to *Friedman*.

12. **In regard to claim 15,** *Friedman* discloses a method comprising the steps of:

at a computer (column 8, lines 19-25),

receiving from a user a selection of a plurality of event contests from among the plurality of contests within an event, and a selection of contestants in each of the selected plurality of the event's contests (column 2, lines 35-45, "wagering on two or more independently determined events..."; as well as column 3, lines 45-50 discussing the application of the method to horse racing),

and establishing a unified wager based on the outcome of the selected contestants in the selected contests (see column 2, lines 25-35; figure 3b and column 5, lines 55-65, discussing the player's "aggregate" (i.e. unified) wager; as well as column 3, lines 45-50 discussing the application of the method to horse racing).

the selections available to the user include selecting a non-consecutive plurality of contests within the event, at the choice of the user, and contestants within the selected contests (column 2, lines 35-45, "wagering on two or more independently determined events..."; as well as column 3, lines 45-50 discussing the application of the method to horse racing); and

at the computer, computing payment to the user a winning on the unified wager based on the performance of the selected contestants in the selected contests (column 4, lines 45-50, "which offers the player an opportunity to cash out the playable amount").

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. **Claims 1-8, 15-17, 22-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,068 to *Brenner et al*, in view of U.S. Patent Publication 2007/0026940 to *Cannella*.

15. **In regard to claims 1-8, 15-17, 22-29** *Brenner et al* discloses a method comprising the steps of:

receiving at a computer from a player choices a plurality of races chosen by the player from among races at an event having a plurality of horse races, the computer permitting the player to choose races of the player's own choosing and permitted by the computer to be non- consecutive (see column 4, lines 20-40; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same),

at the computer, computing payment to paying the player if a number of the selected winners win corresponding chosen races (see column 4, lines 20-40; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the player indicates multiple horses for at least one race of the event (see column 4, lines 20-40; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the choices available to the player permit the player to choose horses in five non- consecutive races (see column 4, lines 20-40; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

paying the user if a predetermined number of the selected contestants wins a corresponding selected event contest (see column 11, lines 25-35, describing players being able to make wagers such as an exacta and trifecta, which are wagers in which a predetermined number of selected contestants win a corresponding race);

the interface further operable to receive from the user a bet on the selected contestants (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same).

16. *Brenner et al* does not disclose allowing the player to choose winners of each of the chosen plurality of the event' s races to be included in a unified wager, **in regard to claims 1, 6, 15, 25**;

wherein the player' s unified wager pays only if all of the selected horses win corresponding chosen races, **in regard to claim 4**;

wherein: the player' s unified wager pays if fewer than all selected horses win their races, **in regard to claims 5, 8, 17, 22 and 24**; nor

after one or more contests are decided, receiving a further unified wager based on selection of a second plurality of event contests from among on the terms of claim 15 from a user based on the remaining contests of the event, the second plurality selected by the user from among the remaining contests, and a second selection of contestants

in each of the second selected plurality of the event's contests, the selections available to the user include selecting a non-consecutive plurality of contests within the event, and establishing a second unified wager based on the outcome of the second selection of contestants, **in regard to claim 23**.

17. In a piece of analogous prior art, *Cannella* teaches a method of horse race wagering, which allows players to choose winners of each of a chosen plurality of races to then be included in a unified wager (see paragraphs 38-42, describing whereby a player makes 12 picks on four races and then places a single wager ("e.g. $9 for a card with 12 picks") on the outcome);

wherein the player' s unified wager pays only if all of the selected horses win corresponding chosen races (see paragraphs 38-42; paragraph 47, "[t]he odds of picking the exact order of finish for the highest number pools...can generate the potential for multimillion-dollar payouts..."; and paragraph 50, "[i]f no winner is declared for a particular number of picks, the total money held would drop into the next set of consecutive races of an equal number,");

wherein the player' s unified wager pays if fewer than all selected wagers were correct (see paragraph 40, "[p]ools may be generated for smaller numbers of correct picks from within the 12 pick pool (e.g., 4 correct picks...) to provide additional incentives to play by increasing winning opportunities."); and

after one or more contests are decided, receiving a further unified wager based on selection of a second plurality of event contests from among on the terms of claim 15 from a user based on the remaining contests of the event, the second plurality selected

by the user from among the remaining contests, and a second selection of contestants in each of the second selected plurality of the event's contests, the selections available to the user include selecting a non-consecutive plurality of contests within the event, and establishing a second unified wager based on the outcome of the second selection of contestants (paragraph 39, "[s]ince the races are continuing, players may enter into the game at each new race. For example a second race in a set of races could be the first race of the next set of races for new players. Therefore…cards may be generated in real-time to accommodate the next set of races, which are about to be run.")

18. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method of horse race wagering which allows players to choose winners of each of a chosen plurality of races to then be included in a unified wager, as taught by *Cannella*. The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers.

19. **Claims 1-3, 5-8, 15-17, 22, 24-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,068 to *Brenner et al*, in view of U.S. Patent 7,727,067 to *Friedman*.

20. **In regard to claims 1-3, 5-8, 15-17, 22, 24-29** *Brenner et al* discloses a method comprising the steps of:

receiving at a computer from a player choices a plurality of races chosen by the player from among races at an event having a plurality of horse races, the computer permitting the player to choose races of the player's own choosing and permitted by the computer to be non- consecutive (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same),

at the computer, computing payment to paying the player if a number of the selected winners win corresponding chosen races (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the player indicates multiple horses for at least one race of the event (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the choices available to the player permit the player to choose horses in five non- consecutive races (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

paying the user if a predetermined number of the selected contestants wins a corresponding selected event contest (see column 11, lines 25-35, describing players being able to make wagers such as an exacta and trifecta, which are wagers in which a predetermined number of selected contestants win a corresponding race); and

the interface further operable to receive from the user a bet on the selected contestants (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

21. *Brenner et al* does not disclose allowing the player to choose winners of each of the chosen plurality of the event' s races to be included in a unified wager, **in regard to claims 1, 6, 15, 25**; nor

wherein: the player' s unified wager pays if fewer than all selected horses win their races, in regard to claims **5, 8, 17, 22 and 24**.

22. *Friedman,* in a related patent regarding a method to implement a wagering game which allows a player to make multiple bets on independent outcomes, teaches allowing a player to choose winners of each of a chosen plurality of events to be included in a unified wager (see column 2, lines 25-35; figure 3b and column 5, lines 55-65, discussing the player's "aggregate" (i.e. unified) wager; as well as column 3, lines 45-50 discussing the application of the method to horse racing) and

wherein the player' s unified wager pays if fewer than all selected wagers were correct (see "Background of the Invention" and "Summary of the Invention" in columns 1 and 2, describing that the method was designed specifically to avoid the situation where a player had to correctly make all his/her wagers, what is discussed as a "parlay" bet).

23. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for wagering which allows a player to make a unified wager on a plurality of independent outcomes, as taught by

Friedman. The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers.

24. **Claims 1-8, 15-17, 22, 24-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,068 to *Brenner et al*, in view of "Accumulators and Combination Betting Explained" (http://www.bbc.co.uk/dna/h2g2/A8799023).

25. **In regard to claims 1-8, 15-17, 22, and 24-29** *Brenner et al* discloses a method comprising the steps of:

receiving at a computer from a player choices a plurality of races chosen by the player from among races at an event having a plurality of horse races, the computer permitting the player to choose races of the player's own choosing and permitted by the computer to be non-consecutive (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same),

at the computer, computing payment to paying the player if a number of the selected winners win corresponding chosen races (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the player indicates multiple horses for at least one race of the event (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the choices available to the player permit the player to choose horses in five non- consecutive races (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

paying the user if a predetermined number of the selected contestants wins a corresponding selected event contest (see column 11, lines 25-35, describing players being able to make wagers such as an exacta and trifecta, which are wagers in which a predetermined number of selected contestants win a corresponding race); and

the interface further operable to receive from the user a bet on the selected contestants (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

26. *Brenner et al* does not disclose allowing the [[a]] player to choose winners of each of the chosen plurality of the event' s races to be included in a unified wager, **in regard to claims 1, 6, 15, 25**;

wherein the player' s unified wager pays only if all of the selected horses win corresponding chosen races, **in regard to claim 4**;

wherein: the player' s unified wager pays if fewer than all selected horses win their races, **in regard to claims 5, 8, 17, 22 and 24**;

27. In an article discussing methods of implementing a wagering game which allow a player to make multiple bets on independent outcomes, "Accumulators and Combination Betting Explained" teaches allowing a player to choose winners of each of a chosen plurality of events to be included in a unified wager (see the discussion of

"The Accumulator," including the discussion of accumulator betting on "simultaneous independent events" (i.e. non-consecutive events))

wherein the player' s unified wager pays only if all of the selected horses win corresponding chosen races (see the discussion of "The Accumulator," including the discussion of accumulator betting on "simultaneous independent events" (i.e. non-consecutive events));

wherein the player' s unified wager pays if fewer than all selected wagers were correct (see the discussion of "Combination Bets," specifically that not all of the sub-bets had to be won in order to win at least some of the overall wager).

28. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for wagering which allows a player to make a unified wager on a plurality of independent outcomes, as taught by "Accumulators and Combination Betting Explained." The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers.

29. **Claims 9-12, 30, 31-34, and 35-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,068 to *Brenner et al*, in view of U.S. Patent Publication 2007/0026940 to *Cannella*.

30. **In regard to claims 9-12,** *Brenner et al* discloses a computer assisted method, comprising the steps of:

receiving at a computer from each of a plurality of players respective selections of pluralities of races from among the races at a racing event, the selected races chosen by each respective player, and receiving at the computer the respective players' predicted winners for each of the respective pluralities of races at the racing event, the selections available to each player permitting the player to choose horses in a non-consecutive plurality of races chosen by the players from among the event' s races, the selections of each player included in respective wagers corresponding to respective players, receiving from each of the plurality of players a bet associated with the wager corresponding to that player, receiving results from races within the racing event (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the selection of races and predicted winners is associated with a game card (see figure 17 and text regarding same);

wherein the number of races that must be selected by each player is established by a sponsor of the wagering system (see column 6, lines 15-20, describing the "pick-n" and "daily double," which are bets in which the sponsor determines the number of races that must be selected by the player, in the case of the pick-n, that being "n" number of races, and two races in the case of the daily double);

wherein the players are further provided the opportunity to indicate multiple horses for at least one race (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein for at least one player of the plurality of players the first selection of races is a subset of nonconsecutive races (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same); and

wherein the players respectively select a single horse for each selected race (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

31. *Brenner et al* does not disclose a player making a unified wager on the outcomes of a plurality of events; pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; nor sending at least a portion of the pool to one or more identified winning players.

32. In a piece of analogous prior art, *Cannella* teaches

a method of horse race wagering, which allows players to choose winners of each of a chosen plurality of races to then be included in a unified wager (see paragraphs 38-42, describing whereby a player makes 12 picks on four races and then places a single wager ("e.g. $9 for a card with 12 picks") on the outcome);

pooling at least a portion of each bet to form a pool (see paragraph 40, "[w]agers may be held in separate pools according to a number of correct picks possible in a particular set of races."); and

identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections and sending at least a portion of the pool to one or more identified winning players (paragraph 49, "[a]fter a result is posted, the money in each pool may be distributed to winners.").

33. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for horse wagering which allows a player to make a unified wager on a plurality of independent outcomes and for those wagers to be pooled, as taught by *Cannella*. The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers, and by providing larger potential payouts by pooling players' wagers.

34. **In regard to claims 30-38** *Brenner et al* discloses a computer assisted method, comprising the steps of:

receiving at a computer a first wager associated with a first player, wherein the first wager identifies of a first plurality of event contests selected by the first player from among the contests at the event, a predicted winner in each of the first plurality of selected contests, and a first wager amount, the choices available to the first player including choosing a non-consecutive plurality of contests from among the contests of the event; receiving at the computer a second wager associated with a second player, wherein the second wager identifies a second plurality of event contests selected by the

second player from among the contests at the event, a predicted winner in each of the second plurality of selected contests, and a second wager amount, the choices available to the second player including choosing winners of a non-consecutive plurality of contests from among the contests of the event, and winners of those contests (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

10. *Brenner et al* does not disclose a player making a unified wager on the outcomes of a plurality of events from claim 30; nor the limitations of claims 31-38.

35. In a piece of analogous prior art, *Cannella* teaches

a method of horse race wagering, which allows players to choose winners of each of a chosen plurality of races to then be included in a unified wager (see paragraphs 38-42, describing whereby a player makes 12 picks on four races and then places a single wager ("e.g. $9 for a card with 12 picks") on the outcome);

pooling at least a portion of each bet to form a pool (see paragraph 40, "[w]agers may be held in separate pools according to a number of correct picks possible in a particular set of races.");

identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections and sending at least a portion of the pool to one or more identified winning players (paragraph 49, "[a]fter a result is posted, the money in each pool may be distributed to winners.");

wherein at least one of the event contests selected by the first player is not included in the plurality of event contests selected by the second player (paragraph 39, "[s]ince the races are continuing, players may enter into the game at each new race. For example a second race in a set of races could be the first race of the next set of races for new players. Therefore...cards may be generated in real-time to accommodate the next set of races, which are about to be run.");

wherein the first player selects contest winners after completion of the first contest of the event (paragraph 39, "[s]ince the races are continuing, players may enter into the game at each new race. For example a second race in a set of races could be the first race of the next set of races for new players. Therefore...cards may be generated in real-time to accommodate the next set of races, which are about to be run.");

receiving a third wager associated with a third player after an event contest in one of the first plurality of event contests and the second plurality of event contests has begun, wherein the third wager identifies a third plurality of winners for each of the third plurality of event contests, and a third wager amount (paragraph 39, "[s]ince the races are continuing, players may enter into the game at each new race. For example a second race in a set of races could be the first race of the next set of races for new players. Therefore...cards may be generated in real-time to accommodate the next set of races, which are about to be run."); and

receiving an additional wager associated with an additional player after a race of the racing event has begun, wherein the additional wager identifies an additional

plurality of winners for an additional plurality of the races at the racing event, and an additional wager amount (paragraph 39, "[s]ince the races are continuing, players may enter into the game at each new race. For example a second race in a set of races could be the first race of the next set of races for new players. Therefore...cards may be generated in real-time to accommodate the next set of races, which are about to be run.").

36. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for horse wagering which allows a player to make a unified wager on a plurality of independent outcomes and for those wagers to be pooled, as taught by *Cannella.* The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers, and by providing larger potential payouts by pooling players' wagers.

37. *Brenner et al*, as modified *Cannella*, does not disclose determining at least one winning player for the pool, when none of the players have predicted correctly the winners of their selected contests. The examiner takes **Official Notice** that the awarding of such a consolation prize or prizes where there was not otherwise a winning play is notoriously well known in the gaming art. Therefore it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to incorporate such a consolation prize or prizes into the computerized wagering system otherwise

disclosed by *Brenner et al*, as modified by *Cannella*, for the purpose of maintaining and prolonging players' interest and involvement in placing wagers.

38. **Claims 9-12, 30, 34, 35, 37, and 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,068 to *Brenner et al*, in view of U.S. Patent 7,727,067 to *Friedman*, further in view of Scarne's New Complete Guide to Gambling (hereafter, "Scarne's").

39. **In regard to claims 9-12,** *Brenner et al* discloses a computer assisted method, comprising the steps of:

receiving at a computer from each of a plurality of players respective selections of pluralities of races from among the races at a racing event, the selected races chosen by each respective player, and receiving at the computer the respective players' predicted winners for each of the respective pluralities of races at the racing event, the selections available to each player permitting the player to choose horses in a non-consecutive plurality of races chosen by the players from among the event' s races, the selections of each player included in respective wagers corresponding to respective players, receiving from each of the plurality of players a bet associated with the wager corresponding to that player, receiving results from races within the racing event (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the selection of races and predicted winners is associated with a game card (see figure 17 and text regarding same);

wherein the number of races that must be selected by each player is established by a sponsor of the wagering system (see column 6, lines 15-20, describing the "pick-n" and "daily double," which are bets in which the sponsor determines the number of races that must be selected by the player, in the case of the pick-n, that being "n" number of races, and two races in the case of the daily double);

wherein the players are further provided the opportunity to indicate multiple horses for at least one race (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein for at least one player of the plurality of players the first selection of races is a subset of nonconsecutive races (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same); and

wherein the players respectively select a single horse for each selected race (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

40. *Brenner et al* does not disclose a player making a unified wager on the outcomes of a plurality of events;

41. In an analogous method to implement a wagering game which allows a player to make multiple bets on independent outcomes, *Friedman* teaches allowing a player to choose winners of each of a chosen plurality of events to be included in a unified wager (see column 2, lines 25-35; figure 3b and column 5, lines 55-65, discussing the player's

"aggregate" (i.e. unified) wager; as well as column 3, lines 45-50 discussing the application of the method to horse racing).

42. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for wagering which allows a player to make a unified wager on a plurality of independent outcomes, as taught by *Friedman*. The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers.

43. *Brenner et al* as modified by *Friedman* does not disclose pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players.

44. In an analogous gaming reference, *Scarne's* teaches pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players (see pg. 50-55).

45. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing a unified wager on a plurality of non-consecutive horse races, as taught by *Brenner et al* as modified by *Friedman*, together with a method for pooling wagers, as taught by *Scarne's*. The motivation

would have been in order to increase player enjoyment and excitement by providing larger potential payouts by pooling players' wagers.

46. **In regard to claims 30, 34, 35, 37, and 38** *Brenner et al* discloses a computer assisted method, comprising the steps of:

receiving at a computer a first wager associated with a first player, wherein the first wager identifies a winner for each of a first plurality of event contests selected by the first player from among the contests at the event, a predicted winner in each of the first plurality of selected contests, and a first wager amount, the choices available to the first player including choosing a non-consecutive plurality of contests from among the contests of the event; receiving at the computer a second wager associated with a second player, wherein the second wager identifies a second plurality of event contests selected by the second player from among the contests at the event, a predicted winner in each of the second plurality of selected contests, and a second wager amount, the choices available to the second player including choosing winners of a non-consecutive plurality of contests from among the contests of the event, and winners of those contests (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

47. *Brenner et al* does not disclose a player making a unified wager on the outcomes of a plurality of events;

48. In an analogous method to implement a wagering game which allows a player to make multiple bets on independent outcomes, *Friedman* teaches allowing a player to choose winners of each of a chosen plurality of events to be included in a unified wager

(see column 2, lines 25-35; figure 3b and column 5, lines 55-65, discussing the player's "aggregate" (i.e. unified) wager; as well as column 7, lines 60-67 discussing the application of the method to other games and events, which would include horse racing).

49. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for wagering which allows a player to make a unified wager on a plurality of independent outcomes, as taught by *Friedman*. The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers.

50. *Brenner et al* as modified by *Friedman* does not disclose pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players, **in regard to claims 30, 34, 35, 37 and 38**.

51. In an analogous gaming reference, *Scarne's* teaches pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players (see pg. 50-55).

52. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing a unified wager on a plurality of non-consecutive horse races, as taught by *Brenner et al* as modified by *Friedman*, together with a method for pooling wagers, as taught by *Scarne's*. The motivation would have been in order to increase player enjoyment and excitement by providing larger potential payouts by pooling players' wagers.

53. *Brenner et al*, modified by *Friedman*, further modified by *Scarne's*, does not disclose determining at least one winning player for the pool, when none of the players have predicted correctly the winners of their selected contests. The examiner takes **Official Notice** that the awarding of such a consolation prize or prizes where there was not otherwise a winning play is notoriously well known in the gaming art. Therefore it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to incorporate such a consolation prize or prizes into the computerized wagering system otherwise disclosed by *Brenner et al*, modified by *Friedman*, further modified by *Scarne's*, for the purpose of maintaining and prolonging players' interest and involvement in placing wagers.

54. **Claims 9-12, 30, 34, 35, 37, 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,068 to *Brenner et al*, in view of "Accumulators and Combination Betting Explained" (http://www.bbc.co.uk/dna/h2g2/A8799023), further in view of Scarne's New Complete Guide to Gambling (hereafter, "Scarne's").

55. **In regard to claims 9-12,** *Brenner et al* discloses a computer assisted method, comprising the steps of:

receiving at a computer from each of a plurality of players respective selections of pluralities of races from among the races at a racing event, the selected races chosen by each respective player, and receiving at the computer the respective players' predicted winners for each of the respective pluralities of races at the racing event, the selections available to each player permitting the player to choose horses in a non-consecutive plurality of races chosen by the players from among the event' s races, the selections of each player included in respective wagers corresponding to respective players, receiving from each of the plurality of players a bet associated with the wager corresponding to that player, receiving results from races within the racing event (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein the selection of races and predicted winners is associated with a game card (see figure 17 and text regarding same);

wherein the number of races that must be selected by each player is established by a sponsor of the wagering system (see column 6, lines 15-20, describing the "pick-n" and "daily double," which are bets in which the sponsor determines the number of races that must be selected by the player, in the case of the pick-n, that being "n" number of races, and two races in the case of the daily double);

wherein the players are further provided the opportunity to indicate multiple horses for at least one race (see column 4, lines 20-35; figure 15 and text regarding

same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

wherein for at least one player of the plurality of players the first selection of races is a subset of nonconsecutive races (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same); and

wherein the players respectively select a single horse for each selected race (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same).

56. *Brenner et al* does not disclose a player making a unified wager on the outcomes of a plurality of events.

57. In an article discussing methods of implementing a wagering game which allow a player to make multiple bets on independent outcomes, "Accumulators and Combination Betting Explained" teaches allowing a player to choose winners of each of a chosen plurality of events to be included in a unified wager (see the discussion of "The Accumulator," including the discussion of accumulator betting on "simultaneous independent events" (i.e. non-consecutive events)).

58. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for wagering which allows a player to make a unified wager on a plurality of independent outcomes, as taught by "Accumulators and Combination Betting Explained." The motivation would have been in

order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers.

59. *Brenner et al* as modified by "Accumulators and Combination Betting Explained" does not disclose pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players.

60. In an analogous gaming reference, *Scarne's* teaches pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players (see pg. 50-55).

61. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing a unified wager on a plurality of non-consecutive horse races, as taught by *Brenner et al* as modified by "Accumulators and Combination Betting Explained", together with a method for pooling wagers, as taught by *Scarne's*. The motivation would have been in order to increase player enjoyment and excitement by providing larger potential payouts by pooling players' wagers.

62. **In regard to claims 30, 34, 35, 37, and 38** *Brenner et al* discloses a computer assisted method, comprising the steps of:

receiving at a computer a first wager associated with a first player, wherein the first wager identifies a winner for each of a first plurality of event contests selected by the first player from among the contests at the event, a predicted winner in each of the first plurality of selected contests, and a first wager amount, the choices available to the first player including choosing a non-consecutive plurality of contests from among the contests of the event; receiving at the computer a second wager associated with a second player, wherein the second wager identifies a second plurality of event contests selected by the second player from among the contests at the event, a predicted winner in each of the second plurality of selected contests, and a second wager amount, the choices available to the second player including choosing winners of a non-consecutive plurality of contests from among the contests of the event, and winners of those contests (see column 4, lines 20-35; figure 15 and text regarding same; figure 16, "More Bets Same Race" and "More Bets Other", and text regarding same);

63. *Brenner et al* does not disclose a player making a unified wager on the outcomes of a plurality of events;

64. In an article discussing methods of implementing a wagering game which allow a player to make multiple bets on independent outcomes, "Accumulators and Combination Betting Explained" teaches allowing a player to choose winners of each of a chosen plurality of events to be included in a unified wager (see the discussion of "The Accumulator," including the discussion of accumulator betting on "simultaneous independent events" (i.e. non-consecutive events)).

65. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing wagers on non-consecutive horse races, as taught by *Brenner*, together with a method for wagering which allows a player to make a unified wager on a plurality of independent outcomes, as taught by "Accumulators and Combination Betting Explained." The motivation would have been in order to increase player enjoyment and excitement by allowing players more flexibility in constructing their wagers.

66. *Brenner et al* as modified by "Accumulators and Combination Betting Explained" does not disclose pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players, **in regard to claims 30, 34, 35, 37 and 38**.

67. In an analogous gaming reference, *Scarne's* teaches pooling at least a portion of each bet to form a pool; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players (see pg. 50-55).

68. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine a computerized method of placing a unified wager on a plurality of non-consecutive horse races, as taught by *Brenner et al* as modified by "Accumulators and Combination Betting Explained", together with a method for pooling wagers, as

taught by *Scarne's*. The motivation would have been in order to increase player enjoyment and excitement by providing larger potential payouts by pooling players' wagers.

69. *Brenner et al*, modified by "Accumulators and Combination Betting Explained", further modified by *Scarne's*, does not disclose determining at least one winning player for the pool, when none of the players have predicted correctly the winners of their selected contests. The examiner takes **Official Notice** that the awarding of such a consolation prize or prizes where there was not otherwise a winning play is notoriously well known in the gaming art. Therefore it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to incorporate such a consolation prize or prizes into the computerized wagering system otherwise disclosed by *Brenner et al*, modified by "Accumulators and Combination Betting Explained", further modified by *Scarne's*, for the purpose of maintaining and prolonging players' interest and involvement in placing wagers.

Double Patenting

70. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

71. **Claims 1, 6, 9, 15, 25, 27 and 30,** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending U.S. Patent application 10/771,221 to *Miller* (the "'221 Application").

72. **As to claims 1, 6, 9, 15, 25, 27 and 30,** they disclose the same subject matter as taught in claims 1, 10, and 19 of the '221 Application. For example, in regard to claim 9 in the instant application and claim 19 in the '221 Application, in their current amended version dated 7/18/2008:

Claim 9	Claim 19 (221 Application)
A computer assisted method, comprising the steps of: receiving at a computer from each of a plurality of players respective selections of pluralities of races from among the races at a racing event,	A method for managing horseracing bets, comprising: receiving a plurality of bets each from a respective bettor, each bet comprising:
the selected races chosen by each respective player,	a selection of five horse races selected by the bet's respective bettor from a plurality of horse races scheduled to be run at a track in a day;
and receiving at the computer the respective players' predicted winners for each of the respective pluralities of races at the racing event, the selections available to each player permitting the player to choose horses in a non-consecutive plurality of races chosen by the players from among the event' s races,	a selection of a respective horse for each of the five horse races selected; wherein at least one selected horse race of a first bet of the plurality of bets comprises a different horse race from at least one selected horse race of a second bet of the plurality of bets;
the selections of each player included in respective unified respective wagers corresponding to respective players; receiving from each of the plurality of	receiving a plurality of bets each from a respective bettor; and a bet amount;

players a bet associated with the wager corresponding to that player;	
pooling at least a portion of each bet to form a pool;	combining each bet amount to form a betting pool
receiving results from races within the racing event; identifying a set of winning players from the plurality of players by determining which of one or more players of the plurality of players correctly selected predicted winners in their respective selections; and sending at least a portion of the pool to one or more identified winning players.	determining an amount of a total payout for the day based at least in part on the betting pool; receiving results of the plurality of horse races scheduled to be run, the results identifying a winning horse for each of the plurality of horse races scheduled to be run; determining one or more winning bets of the plurality of bets by determining for each of the plurality of bets if each selected respective horse corresponds to the winning horse for each of the five horse races selected in the bet; and determining an amount to be paid for each winning bet based on the number of winning bets, the amount of the total payout and the bet amount of each winning bet.

73. While the conflicting claims are not identical, they are not patentably distinct from each other. As to the small differences between the claims, at the time of invention, it would have been obvious to a person of ordinary skill in the art to have made the few minor modifications to the cited claims in the '221 Application necessary to create claims 1, 6, 9, 15, 25, 27 and 30 in the instant application.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mike Grant whose telephone number is 571-270-1545. The Examiner can normally be reached on Monday through Friday between 8:00 a.m. and 5:00 p.m., except on the first Friday of each bi-week.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisory Primary Examiner, Dmitri Suhol can be reached at 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MCG/

/Dmitry Suhol/

Supervisory Patent Examiner, Art Unit 3716